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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,350	09/13/2005	Yoshiaki Hirose	266983US0XPCT	3014
22850	7590	07/13/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MILLER, DANIEL H	
			ART UNIT 1775	PAPER NUMBER
			NOTIFICATION DATE 07/13/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/526,350	<b>Applicant(s)</b> HIROSE ET AL.	
	<b>Examiner</b> Daniel Miller	<b>Art Unit</b> 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 1-9 in the reply filed on 6/18/2007 is acknowledged. The traversal is on the ground(s) that no serious burden exists under MPEP section 803 and that unity of invention exists. This is not found persuasive because since this is a national stage application MPEP section 803 is not the prevailing statute under which the restriction is being determined. Therefore applicant's reliance upon this MPEP section is improper. Instead, the PCT rules are what apply in this case.
2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The oxidation resistant coating of claim 1 does not have to contain a phosphorous or Boron element but could be a silicon carbide coating instead wherein claim 10 requires phosphorous or Boron to be present. Applicant has not addressed this argued distinction between the independent claims.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

3. The information disclosure statement filed 3/3/2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kondo et al (US 4,244,934).

6. It is noted that applicant, in page 4 of the instant specification, defines a coating layer to include more than a distinct layer. "Forming a coating layer includes forming a so-called coating on a surface of a shaped expanded graphite article, forming the coating on a shaped expanded graphite article and at the same time incorporating (impregnating) a part of the coating into the shaped expanded graphite article, and incorporating (impregnating) the coating to a certain depth (including to a core) of the shaped expanded graphite article, all of which are defined as being within the scope of the phrase coating layer."

7. Kondo teaches expanded graphite sheet impregnated with an antioxidant comprising a boric acid ester (abstract). This is expected to meet the limitation of an oxidation-resistant coating layer as defined in applicant's specification.
8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by EP (1211221A1).
9. It is noted that applicant, in page 4 of the instant specification, defines a coating layer to include more than a distinct layer. "Forming a coating layer includes forming a so-called coating on a surface of a shaped expanded graphite article, forming the coating on a shaped expanded graphite article and at the same time incorporating (impregnating) a part of the coating into the shaped expanded graphite article, and incorporating (impregnating) the coating to a certain depth (including to a core) of the shaped expanded graphite article, all of which are defined as being within the scope of the idea of coating layer."
10. EP (1211221A1) teaches expanded graphite sheet impregnated with a phosphorous pentoxide and phosphate antioxidant (abstract). This is expected to meet the limitation of an oxidation-resistant coating layer as defined in applicant's specification.

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***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al (US 4,244,934) in view of EP (1211221A1).

13. Kondo in view of EP (1211221A1) are silent as to graphite containing both a boron and phosphorous element.

14. However, Kondo teaches expanded graphite sheet impregnated with an antioxidant comprising a boric acid ester (abstract), which is considered an organic boron compound in accord with applicant's claim 6. Regarding claim 3, the concentration of boric acid is 2 to 30% aqueous, which is then added to the graphite at 30% to 50% by weight (see column 7 thru 9), overlapping applicant's claimed range of Boron.

15. EP (1211221A1) teaches expanded graphite sheet impregnated with a phosphorous pentoxide (a phosphorous compound) and phosphate antioxidant (abstract). Regarding claim 4 the phosphorous pentoxide (a phosphorous compound) and phosphate antioxidants are present at up to 5% and 16% respectively, overlapping applicants range.

16. "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be

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used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

17. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a graphite sheet with both boron and phosphorous present in order to achieve an additive effect of increased oxidation protection.

18. Regarding claims 5 and 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the particle size and coating thickness to increase oxidation stability, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Miller whose telephone number is (571) 272-1534. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel Miller



JENNIFER C. MCNEIL  
SUPERVISORY PATENT EXAMINER

7/9/17